

Appl. No. 09/940,378  
Amdt. dated November 17, 2005  
Reply to Office Action of September 1, 2005

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### REMARKS

Applicants have received and carefully reviewed the Office Action mailed September 1, 2005. Claims 105, 109-112, 116-119 and 121-122 remain pending, with claims 105 and 121 amended as set forth above. Reconsideration and reexamination are respectfully requested.

In paragraph 3 of the Office Action, claims 121-122 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,243,977 to Trabucco et al.

Claim 121 has been amended to further recite that one of the electrodes is disposed on a lead electrode assembly coupled to the canister. Trabucco et al. show a device where no lead assembly is provided. For example, in the Abstract, Trabucco et al. state "whereby no plug-receptacle nor electrode catheter is required." Trabucco et al. discuss, in the background of the invention, disadvantages associated with the inclusion of a lead or catheter. Trabucco et al. further state "Thus the pacemaker itself may be reduced in size, since it does not require a plug-receptacle housing to fix the electrode, which as already stated, is disposed of." Trabucco et al. at column 2, lines 35-37. Applicants assert that Trabucco et al. do not disclose a device having a lead electrode assembly, and teach away from the inclusion of such a lead electrode assembly.

In light of the above, claims 121-122 are patentable over the cited reference.

In paragraph 5 of the Office Action, claims 105, 112, 116 and 117 were rejected under 35 U.S.C. §103(a) as being unpatentable over Trabucco et al. in view of U.S. Patent No. 4,940,054 to Grevis et al.

Claim 105 has been amended. Claim 105 now recites, in part, a method that includes the use of an electrode pair including a first electrode disposed on a stimulus device housing and a second electrode disposed on a lead electrode assembly coupled to the stimulus device. As noted

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above, Trabucco et al. do not illustrate and, further, teach away from the inclusion of a lead electrode assembly. Grevis is cited to indicate that some sensing may be performed.

The burden of establishing a *prima facie* case of obviousness lies with the Examiner. A recited claim element has not been addressed in the rejection. The primary reference cannot be modified consistently with the teachings of Trabucco et al. to include the recited electrode on a lead electrode assembly. Therefore, claim 105 is believed to be allowable over the cited combination. For similar reasons, dependent claim 116 is also believed to be patentable over the cited combination.

Claim 112 and claim 117 each recite a method which includes providing an implantable device that is coupled to a lead system including at least one electrode. As noted above, Trabucco et al. teach away from the inclusion of a lead electrode assembly, and Grevis does not provide what Trabucco et al. lack. As the cited combination fails to disclose all of the claimed elements in claim 112 and 117, a *prima facie* case of obviousness has not been established. Therefore, claims 112 and 117 are believed to be allowable.

In paragraph 6 of the Office Action, claims 118-119 were rejected under 35 U.S.C. §103(a) as being unpatentable over Trabucco et al. in view of Grevis et al. and further in view of U.S. Patent No. 5,331,966 to Bennett et al. Bennett et al. is cited to illustrate the inclusion of a sensing electrode that is not a stimulus electrode. Claims 118-119 both depend from claim 117 and are therefore subject to similar analysis as claim 117. Specifically, the primary reference, Trabucco et al., cannot be modified consistent with its own teachings to include the lead system recited in claim 117. Therefore, it is believed that claims 118-119 are patentable over the cited combination.

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Applicants would like to thank the Examiner for noting the allowability of claims 109-111.

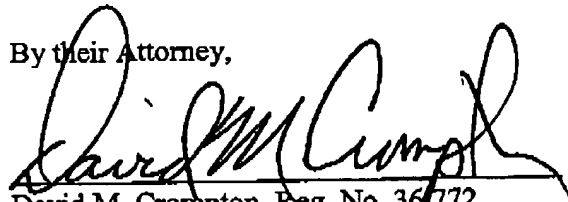
Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Gust H. Bardy et al.

By their Attorney,

Date: 11/17/05



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